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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,227	08/18/2003	Thomas D. Ray III	066575-0008	2201

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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 10/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/642,227

Applicant(s)

RAY ET AL.

Examiner

Patricia L. Nordmeyer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 12-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 25-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Withdrawn Rejections

1. The 35 U.S.C. 102(e) rejection of claims 1 – 11 as anticipated By Treleaven et al. in the office action dated May 27, 2005 is withdrawn due to Applicant's arguments in the response dated August 29, 2005.

New Rejections

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1 – 11 and 25 – 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrases "inner and outer sections", "inner section" and "outer sections" in claims 1, 4, 6, 9, 25 and 28 are unclear, which render the claims vague and indefinite. It is unclear from both the drawings and the specification what the terms "inner and outer sections", "inner section" and "outer sections" are disclosing. There is no mention of the either section in the specification or the drawings.

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Claims 2, 3, 5, 7, 8, 10, 11, 26, 27 and 29 are also rejected under 35 U.S.C. 112 2nd paragraph due to their dependency on the above rejected claims.

Correction/clarification is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 – 11 and 25 – 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barry in view of Treleaven et al.

Barry disclose a label comprising a liner including inner and outer sections on a first surface thereof (Figure 1, #5), a booklet, hinged layers, including first and second surfaces (Column 2, lines 36 - 43), said first and surface of said booklet being supposed substantially adjacent said inner section on said first surface of said liner (Figure 1, #7), a first laminate being adhesively affixed to said second surface of said booklet and including inner and outer sections on first and second faces thereof (Figure 2, #6), said inner section of said first face of said first laminate being affixed to said booklet, said outer section of said first faces of said first laminate being affixed to said outer section of said liner to substantially enclose said booklet between said first laminate (Column 3, lines 20 – 23; Figure #46) and said liner as in claim 1, 6 and 25. The

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liner and first and second laminates are made of transparent material (Column 3, line 20) with the second face of the liner having an adhesive layer (Column 3, line 20) as in claims 2, 3, 7, 8, 26 and 27. With regard to claims 5 and 10, (Page 6, Paragraph 0064). The surface area of the IRC may be substantially smaller than a surface area of said booklet (Figure 15) as in claim 11. However, Barry fails to disclose an IRC disposed substantially adjacent said inner section on said second face of said first laminate and having a second laminate including inner and outer sections on first face thereof, said inner section of said second laminate being affixed to said IRC and said outer section of said second laminate being affixed to said outer section of said second face of said first laminate, the outer sections of said liner and first and second laminates include perforations for separating the IRC from the paperback rider IRC, the IRC is a coupon, a game-piece, an instant winner coupon, a warning, a scratch-off piece, a warranty, instructions, description and a collectible sticker and an IRC is disposed on a second face of said laminate and releasably affixed thereto by a dry release adhesive for permitting separation.

Treleven et al. teach a paperback rider instantly redeemable coupon comprising an IRC disposed substantially adjacent said inner section on said second face of said first laminate and having a second laminate including inner and outer sections on first face thereof, said inner section of said second laminate being affixed to said IRC and said outer section of said second laminate being affixed to said outer section of said second face of said first laminate (Page 4, Paragraph 0044), the outer sections of said liner and first and second laminates include perforations for separating the IRC from the paperback rider IRC (Page 4, Paragraph 0042), the IRC is a coupon, (Page 6, Paragraph 0064) disposed on a second face of said laminate and

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releasably affixed thereto by a dry release adhesive for permitting separation (Page 6, Paragraph 0064) for the purpose of forming a label that has increased amount of label area while still including area for tracking information or coupons (Page 1, Paragraph 003).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the IRC coupon as a layer in Barry in order to form a label that has increased amount of label area while still including area for tracking information or coupons as taught by Treleaven et al.

Response to Arguments

6. Applicant's arguments with respect to claims 1 - 11 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia L. Nordmeyer
Examiner
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[Signature]
HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772 10/25/05